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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,925	12/03/2003	Reiner Jung	20813/0205184-US0	4697

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EXAMINER
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LAVIN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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2624

MAIL DATE	DELIVERY MODE
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06/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/726,925

Applicant(s)

JUNG, REINER

Examiner

Christopher L. Lavin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/03/03; 04/12/04; 08/05/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 12/04/02. It is noted, however, that applicant has not filed a certified copy of the patent application as required by 35 U.S.C. 119(b). **Claim**

### ***Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over combination of Finkbeiner (2003/0103662) and MetaMorph (archived website <http://www.universal-imaging/metamorph> archived on “10/13/02” by the Wayback Machine at [www.archive.org](http://www.archive.org)).

In regards to claim 1, Finkbeiner teaches A method for controlling image recording, comprising: actuating, using a control unit, equipment for the image recording, said equipment including a camera (paragraph 63, 69 80, and 96; Figure 1, items 14, 36, 18, and 40: Every camera has a control unit embedded that receives instructions from the computer. Each of the boxes is part of an overall control unit designed to run the microscope using scripts.); processing, using a computer unit, image data of the image recording (paragraph 96); combining a plurality of control commands for the image recording so as to form at least one script; and transmitting the at least one script from the computer unit to the control unit (Paragraphs 69, 80, and 96).

Although Finkbeiner provides all of the teachings of the current claim, as Finkbeiner is relying on the MetaMorph software suite to provide for the scripting and image processing the examiner has included a print out of the entire MetaMorph website (from 2002) to show further detail on the scripting and image processing. As Finkbeiner calls for using MetaMorph it would have been obvious to one having ordinary

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skill in the art to combine these two references, as the MetaMorph teaching simply provides further details on the program used by Finkbeiner.

In regards to claim 2, The method as recited in claim 1 wherein the at least one script includes a plurality of scripts and further comprising saving a plurality of scripts in the computer unit (MetaMorph: pages 8 - 12).

In regards to claim 3, The method as recited in claim 1 wherein the combining is performed using the computer unit so as to at least one of newly generate, amend and supplement the at least one script (MetaMorph: pages 8 – 12: The program runs on the computer and therefore the combining, generating, and amending would happen on the computer.).

In regards to claim 4, The method as recited in claim 1 further comprising sending a starting signal to the control unit using the computer so as to start the image recording (MetaMorph: The MetaMorph software is used to control the microscope and therefore would provide a starting signal.).

In regards to claim 5, The method as recited in claim 1 wherein the transmitting is performed by transmitting to the control unit only a respective script of the at least one script to be executed at a given time (MetaMorph: The instructions are sent for that application, not all applications).

In regards to claim 6, The method as recited in claim 1 further comprising encrypting the at least one script (MetaMorph: The script needs to be formatted in such away as to send it to the microscope, any formatting of the script would be a form of

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encryption, as the term is not fully defined in the claims and therefore is provide with a broad interpretation.

In regards to claims 7 - 11, claims 7 – 11 are rejected for the same reasons as claims 1 - 5. The argument analogous to that presented above for claims 1 - 5 is applicable to claims 7 – 11.

In regards to claim 12, An apparatus for multi-dimensional image recording, comprising: a control unit configured to initiate the image recording (Figure 1, items 14, 36, 18, and 40); a camera configured to record an image of an object captured by a microscope so as to form image data (Figure 1, item 14); a computer unit configured to receive and process the image data and to provide at least one script including a plurality of control commands for the image recording, the computer unit being connectable to the control unit so as to enable a transmitting of the at least one script (Figure 1, item 16).

In regards to claim 13, The apparatus as recited in claim 12 further comprising an illuminating device configured to illuminate the object (Figure 1, item 22).

In regards to claim 14, The apparatus as recited in claim 12 further comprising a moving device configured to move the object (Figure 1, item 6).

In regards to claim 15, claim 15 is rejected for the same reasons as claim 1. The argument analogous to that presented above for claim 1 is applicable to claim 15.

In regards to claim 16, The computer readable medium as recited in claim 15 wherein the computer executable process steps are executable using the computer unit (MetaMorph).

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In regards to claim 17, The computer readable medium as recited in claim 15 wherein the computer executable process steps are executable using the control unit (MetaMorph).

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. US Pat. 6,987,266 – discloses scripting for microscopes.
8. US Pat. 6,266,182 – Teaches of a microscope with a CCD and a control unit.
9. US Pat. Application 20020048813 – Teaches of using a microscope.

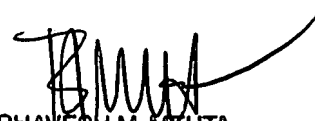
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Lavin whose telephone number is 571-272-7392. The examiner can normally be reached on M - F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Lavin



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